

REMARKS

Claims 59, 64, and 66-69 are pending in this application. Claims 1-55 have been previously canceled; Claims 56-58, 60-63, and 65 have been previously withdrawn; Claims 59, 64, and 66-69 have been amended; and Claims 70-81 have been added. By the present amendments, Claims 59, 64, 66-69, and 70-81 remain pending. In light of the above listed amendments and the remarks below, the Applicants respectfully assert that no new matter has been added, and the application is now in condition for allowance. The Applicants respectfully solicit an indication of such an allowance.

Claim Rejections Under 35 U.S.C. § 112

In the final Office Action, Claims 64 and 67 were rejected under 35 U.S.C. § 112, sixth paragraph because allegedly no function is specified by the word(s) preceding “means,” and therefore it is “impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph.” (Office Action, page 2). The Applicants respectfully contend that for amended Claims 64 and 67 a description of the intended function follows each use of the terms “means for.”

In addition, the Federal Circuit in *Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, Civ. No. 2007-1419 (Fed. Cir. Mar. 28, 2008) held that when the corresponding structure of a means-plus-function limitation is a standard microprocessor programmed to perform an algorithm, the specification must also sufficiently disclose the algorithm. While a source code listing or a highly detailed algorithm are not required, disclosure of a specific algorithm or steps is necessary under § 112, ¶ 6 to transform a general purpose microprocessor to a special purpose computer programmed to perform the recited function. *Id.*

The Applicants respectfully contend that the means plus function claim elements described in Claims 64 and 67 are covered in the specification. FIGS. 2A-2B shows the structure of the system that includes the source systems, remittance payment processor, merchant database, etc. utilized and/or referenced in amended Claims 64 and 67. The algorithm of FIG. 3 shows the process of identifying a payee in a merchant database and FIG. 5 shows the process of directing a payment as described in amended Claims 64 and 67. Furthermore, the associated text in the specification that discuss these figures provides additional detail. Accordingly, the

Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn with respect to independent amended Claims 64 and 67.

Claim Rejections Under 35 U.S.C. § 101

In the final Office Action, Claim 66 was rejected under 35 U.S.C. § 101 because the claimed invention is software per se. The Applicants respectfully disagree with the Examiner's rejection. Nevertheless, the Applicants assert that the amendments to Claim 66 has rendered the rejection under 35 U.S.C. § 101 moot. For instance, the claim has been amended to more clearly identify the apparatus (e.g., source system processor, remittance payment processor) performing each of the recited claim elements.

Claim Rejections Under 35 U.S.C. § 103

In the final Office Action, Claims 59, 64, and 66-69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,920,847 to Kolling et al. (hereinafter "*Kolling*") in view of U.S. Patent No. 6,968,319 to Remington et al. (hereinafter "*Remington*"). The Applicants assert that amended independent Claim 59 is allowable over the combination of *Kolling* and *Remington* for at least the reason that neither *Kolling* or *Remington* teach, suggest, or motivate the merchant payment processing system residing at the source while the remittance processing is performed by a separate entity (e.g., the remittance payment processor), as required by the each of the pending independent claims.

By having a merchant payment processing system residing at a source system and collaborating with a separate remittance payment processor, both the remittance payment processor and the merchant payment processing system residing at the source system may be leveraged for its unique advantages. The remittance payment processor can perform processing that leverages its centralized knowledge of payee information captured in a merchant database. The source system then leverages connectivity and payment issuance capabilities it may already have to direct payment in accordance with instructions obtained from the remittance payment processor. Hence, the source system has greater control over payment submissions as well as the ability to customize their payment processing protocols avoiding the need for an additional

expense of having another entity process payments. Additionally, by centralizing the remittance payment processor functionality, the source system shifts the function of generating specific payment instructions to a remittance processing system thereby utilizing the remittance processing systems merchant information thereby providing additional efficiency for the source system to implement its own payment instructions.

Support for such collaboration between the remittance payment processor and the merchant payment processing system residing at the source system described in amended independent Claim 59 may be found at page 18 of the specification with reference to FIG. 2B:

It should be understood that the merchant payment processing system could be multiple systems which respectively reside with each source 7 Hence each source processing system 7 collects payment requests made by consumers in its consumer base and the one or more merchant payment systems 25 makes payments on behalf of these consumers 8 in accordance with payment directions from the centralized RPP 3.

(See 09/010,193, page 18; FIG. 2B).

The Applicants respectfully assert that *Kolling* and *Remington* fail to teach suggest or motivate the following claim elements of amended independent Claim 59:

receiving, from the remittance payment processor, a set of payment instructions generated by the remittance payment processor, wherein the generation of the set of payment instructions included identifying a payee in a merchant database based, at least in part, on information in a payment request of the set of payment requests and retrieving information associated with the payee from the merchant database, wherein the information is included in a payment instruction of the set of payment instructions; and

issuing, by the source system processor, payments in accordance with the set of payment instructions received from the remittance payment processor including a payment associated with the payment request, wherein the payment is made to the identified payee.

In other words, neither *Kolling* nor *Remington* teaches, suggests, or motivates separating the merchant payment processing with the source of the payment request while centralizing the generation of payment instructions at a remittance payment processor. Therefore, the Applicants respectfully assert that amended independent Claim 59 is in condition for allowance. The

Applicant: Garrison et al.
Filed: January 21, 1998
Application No.: 09/010,193

Applicants further respectfully assert that amended independent Claims 64, and 66-69 are also in condition for allowance for at least the same reasons as amended independent Claim 1.

Moreover, the Applicants respectfully assert that each of the pending dependent claims are allowable as a matter of law as being dependent on allowable base claims, notwithstanding the independent recitation of patentable subject matter that may be described in one or more of the dependent claims.

Applicant: Garrison et al.
Filed: January 21, 1998
Application No.: 09/010,193

CONCLUSION

It is not believed that extensions of time or fees for addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,

/William T. Cook/
William T. Cook
Registration No. 58,072

Dated: October 15, 2008
SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996
(404) 853-8253
(404) 853-8806 (fax)
SAB Docket No.: 23952-0046